

REMARKS

Claims 1 - 52 are pending in the present application. Claims 9, 10, 19, 30, 39, 41, 45 and 49 were amended to cure minor typographical errors. Claims 51 and 52 were added. No claims were canceled. Reconsideration of the claims is respectfully requested.

I. Examiner Interview

Applicants' representative made several attempts to procure an interview with the Examiner and the Examiner's supervisor in an effort to expedite the persecution of the presently claimed intention. Applicants' representative was unsuccessful, in part, because the Examiner could not locate the file wrapper for the present application, and essentially denied an interview on the substantive merits even though Applicants' representative offered to provide the Examiner with copies of ALL pertinent information including the patent application specification as filed, Office Actions, cited prior art and Applicants' responses.

II. Claim Rejections - 35 USC § 103

The Examiner has rejected claims 1-50 35 U.S.C. 103(a) as being unpatentable over Applicants' submission of Swanson *et al.* (U.S. Patent No. 6,112,183). It should be noted that Swanson *et al.* has been of record since the filing date and therefore could have been relied on by the Examiner in the previous Non-Final Office Action. This rejection is respectfully traversed.

Claims 1, 9, 11, 21, 29, 31 and 41:

With regard to the present outstanding Non-Final Office Action, the Examiner stated:

With respect to claims 1 and 21 Swanson teaches:
receiving a request for a value of a data item (the client request)
(col. 5, lines 5-10);

identifying an ancillary system associated with the requested data item (the client stub 60 locates the appropriate server to handle the request) (col. 6, lines 38-46);

processing the data into the value for the data item and returned the requested value for the data item (the client stub 60 unpacks the output argument and returns them to the client application (col. 6, lines 63-65).

Swanson does not explicitly teach determining whether data stored in the ancillary system is conducive to being processed into the value; retrieving the data from one of the ancillary systems and the data processing system based on whether data stored in the ancillary system is conducive to being processed into the value. However, Swanson teaches, "the request 64 for member enrollment information bay be made by program 54 in the benefit subsystem 30. The benefit subsystem 30 holds information regarding the benefit plans" (col. 6, lines 21-25). In addition, Swanson teaches, "server stubs 62 are responsible for listening for client requests, unpacking the input arguments, validating server access, calling server function, packaging the return value and output arguments returned by the server code, recording audit information, gathering performance data and passing return value and output arguments back to client stub 60 over network 10" (col. 7, lines 8-14). This teaches the server returned a value corresponding to the input parameters. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to process the request and return to a value as taught in Swanson to allow the processing the data in the stored data in the system.

...

With respect to claim 41 recites similar limitations as discussed in claims 1 and 2, Swanson also teaches ancillary system access rules (col. 7, lines 32-37).

Applicant's representative respectfully disagrees with both the Examiner's characterization of the cited prior art and to its applicability to the present claims. In essence, the Examiner has pointed to no more in Swanson *et al.* than Applicants have admitted on pages 9-10 of the background section, but then and without discussion, the Examiner alleges that the remaining claim limitations would be obvious in view of the known disclosure of Swanson *et al.* The Examiner has made no more than a general allegation that, in the opinion of the Examiner, the present claims are not patentable.

Using this type of rationale as the basis of a rejection under 35 U.S.C. 103 is strictly prohibited.

Applicants' representative reminds the Examiner that in *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Patent Office always bears the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). The inventor does not have the duty to produce evidence of non-obviousness. Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). The inquiry is not whether each claimed element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art. If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicants are entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

Claim 1 recites:

A data processing system implemented method for managing data from a plurality of ancillary systems comprising:

receiving a request for a value of a data item;

identifying an ancillary system associated with the requested data item;

determining whether data stored in the ancillary system is conducive to being processed into the value;

retrieving the data from one of the ancillary system and the data processing system based on whether data stored in the ancillary system is conducive to being processed into the value;

processing the data into the value for the data item; and
returning the requested value for the data item.

Even assuming, *arguendo*, that Swanson *et al.* teach "receiving a request for a value of a data item," and then "identifying an ancillary system associated with the requested data item," nowhere can Applicants' representative find any mention that Swanson *et al.* so much as considered the possibility that the data stored in the ancillary system might not be conducive to being processed into the value. Therefore, Swanson *et al.* cannot suggest "determining whether data stored in the ancillary system is conducive to being processed into the value," as recited in the base claims.

Moreover, Swanson *et al.* do not teach, suggest or otherwise obviate "retrieving the data from one of the ancillary systems and the data processing system based on whether data stored in the ancillary system is conducive to being processed into the value," because Swanson *et al.* apparently assumes a server stub 62 will be available for "processing the data into the value for the data item" as recited in the claims. Swanson *et al.* simply do not suggest that one is not available, nor does the Examiner. Nowhere does Swanson *et al.* suggest an alternative source for retrieving the requested data.

Using the Examiner's analogy of Swanson *et al.*, the sole location for retrieving any data is a server (or ancillary system). Nowhere does Swanson *et al.* suggest the possibility of retrieving data from a data processing system which is separate from the server (or ancillary system) and nowhere does the Examiner suggest that Swanson *et al.* do. Therefore, Swanson *et al.* teach and suggest no more than the admitted prior art, and the Examiner does not suggest otherwise.

Since Swanson *et al.* do not teach or suggest "determining whether data stored in the ancillary system is conducive to being processed into the value," and furthermore since Swanson *et al.* do not teach or suggest "retrieving the data from one of the ancillary

systems and the data processing system based on whether data stored in the ancillary system is conducive to being processed into the value," Swanson *et al.* do not teach or suggest each limitation of the present claims. Moreover, even if the Examiner could point to prior art references which suggest that the missing claimed element may have existed in the prior art, the Examiner has certainly not shown that the claimed invention as a whole is obvious in light of Swanson *et al.* The Examiner has not met the burden of producing the claimed elements in the prior art, nor does the Examiner allege that Swanson *et al.* teach or suggest each of the claimed limitations, but instead makes a general allegation that they would be obvious. Therefore, the Examiner has not established a *prima facie* case of obviousness.

It is well understood that one function of the *prima facie* burden is to require the Patent Office to set forth specific objections, which can be met by the Applicant, and not just make general rejections. *In re Epstein*, 32 F.3d 1559, 31 U.S.P.Q.2D 1817, 1820 (Fed. Cir. 1994) (Plager, J., concurring). "The Examiner cannot sit mum, leaving the Applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the Examiner." *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., concurring).

It is respectfully asserted that rejection of claims **1, 9, 11, 21, 29, 31 and 41** has been overcome and those claims are in condition for allowance.

Claims 2, 20, 22, 40, 41 and 42:

With regard to these claims, the Examiner states:

As to claims 2, 22, and 42, Swanson further discloses identifying all data updated in the ancillary system since a last block transfer of data to the data processing system; requesting a block transfer of updated data from the ancillary system; and copying the block of updated data to the data processing system (col. 5, line 1-5).

...

As to claims 9, 11, 29, and 31 recite similar limitations as discussed in claims 1 and 21; therefore, claims 9 and 29 are also rejected for the same reasons as given in claims 1 and 21.

...

As to claims 20 and 40, recite similar limitations as discussed in claims 2, 22, and 42; therefore, claims 20 and 40 are also rejected for the same reasons as given in claims 2, 22, and 42.

More specifically Swanson *et al.* teach:

The requests for transaction service are generally implemented as remote procedure calls (RPCs). Remote procedure calls are ideally suited to handling multiplicity of health care transactions. Once modified to handle health care transactions, RPCs provide a method for communication among systems with very different types of data maintained in very different formats and computing environments while maintaining the integrity and character of that data. Though the client request is generated in one computer system 12 or subsystem 26-50 and the requested information lies within another computer system 12 or subsystem 26-50, the communication interface 22 provides a common interface for completing the transaction service requested by the RPC (col. 5, lines 1-13).

Nothing in the passage reproduced above even remotely suggests "identifying all data updated in the ancillary system since a last block transfer of data to the data processing system," as recited in claim 2, much less "requesting a block transfer of updated data from the ancillary system," and "copying the block of updated data to the data processing system," as further recited in that claim. It is simply not understood how such a general description as that pointed to by the Examiner in Swanson *et al.* could suggest the particularly claimed limitations of claims 2, 20, 22, 40, 41 and 42.

Since Swanson *et al.* do not teach or suggest each of the limitations in the above identified claims, the Examiner has not established a *prima facie* case of obviousness. It is respectfully asserted that rejection of claims 2, 20, 22, 40, 41 and 42 has been overcome and those claims are in condition for allowance.

Claims 3, 23, and 43:

With regard to these claims, the Examiner states:

As to claims 3, 23, and 43, Swanson further discloses wherein processing the data into the value for the data item is performed subsequent to copying and prior to receiving the request (col. 7, lines 8-14).

This rejection is traversed as being facially flawed. Nowhere in the cited portion does Swanson *et al.* even suggest that "processing the data into the value for the data item is performed subsequent to copying and prior to receiving the request," as recited in the above identified claims, but instead Swanson *et al.* teach the contrary. Specifically, Swanson *et al.* states:

Server stubs 62 are responsible for listening for client requests, unpacking the input arguments, validating server access, calling server function, packaging the return value and output arguments returned by the server code, recording audit information, gathering performance data and passing return value and output arguments back to client stub 60 over network 10 (col. 7, lines 8-14).

Thus, server stubs **62**, relied on by the Examiner as a rationale for the rejection, are "responsible for listening for client requests" prior to "packaging the return value and output arguments returned by the server code." According to the presently claimed invention, however, the data may be pre-processed prior to receiving the request, *inter alia*, in the data processing system.

Since Swanson *et al.* do not teach or suggest each of the limitations in the above identified claims, the Examiner has not established a *prima facie* case of obviousness. It is respectfully asserted that rejection of claims **3, 23, and 43** has been overcome and those claims are in condition for allowance.

Claims 8 and 28:

With regard to these claims, the Examiner states:

As to claims 8 and 28, Swanson further discloses attempting to contact the ancillary system based on the data stored in the ancillary system being conducive to being processed into the value (col. 5, lines 5-10); and receiving the data from the ancillary system based on the ancillary system being unresponsive, (col. 5, lines 5-10).

This rejection is traversed as it is respectfully asserted that the Examiner has mischaracterized Swanson *et al.*

Claim 8 recites:

The data processing system implemented method recited above in claim 1, wherein retrieving the data from one of the ancillary systems and the data processing system further comprises:

attempting to contact the ancillary system based on the data stored in the ancillary system being conducive to being processed into the value; and

receiving the data from the data processing system based on the ancillary system being unresponsive.

Regarding requesting data Swanson *et al.* state:

Though the client request is generated in one computer system 12 or subsystem 26-50 and the requested information lies within another computer system 12 or subsystem 26-50, the communication interface 22 provides a common interface for completing the transaction service requested by the RPC.

Moreover, Swanson *et al.* go on to describe exactly how a server responds to a request:

Once a server is built and logged on to the network 10, the server is ready to process requests from a client. The type of requests that the server will process depends on whether the server supports applications 14 for the user interface tier 16, business logic tier 18 or data access tier 20. (col. 5, lines 61-650 (emphasis added)

Thus, rather than teaching a request processing hierarchy predicated on retrieving the data from the ancillary system, if responsive and only then progressing to the data processing system, Swanson *et al.* teach a bi-directional communication interface 22 for

processing request and receiving information from any of computer system 12 or subsystem 26-50. While the use of a bi-directional communication interface may not be inconsistent with other aspects of the present invention, it is most certainly not suggestive of the claimed request processing hierarchy.

Since Swanson *et al.* do not teach or suggest each of the limitations in the above identified claims, the Examiner has not established a *prima facie* case of obviousness. It is respectfully asserted that rejection of claims 8 and 28 has been overcome and those claims are in condition for allowance.

Claims 10 and 30:

With regard to these claims, the Examiner states:

As to claims 10 and 30, Swanson further discloses catching a message, wherein the message was generated by an ancillary system using a set of content rules and the message conforms to a message standard; opening the message; identifying the ancillary system based on the message, (col. 58, lines 38-42); accessing content conversion rules based on the identity of the ancillary system, (col. 48, lines 19-24); converting content from the message to enterprise information using the content conversion rules, (col. 48, lines 19-24); and storing the enterprise information in the data processing system, (col. 58, lines 27-28).

Claim 10 recites:

catching a message, wherein the message was generated by an ancillary system using a set of content rules and the message conforms to a message standard;

opening the message;

identifying the ancillary system based on the message;

accessing content conversion rules based on the identity of the ancillary system;

converting content from the message to enterprise information using the content conversion rules; and

storing the enterprise information in the data processing system.

Firstly, it is not immediately clear which passages are being relied upon by the Examiner because the cited reference consists of only 28 columns. Even supposing a message were "caught," as described in the present specification, Swanson *et al.* do not teach or suggest a sequence of "opening the message," "identifying the ancillary system based on the message," and then "accessing content conversion rules based on the identity of the ancillary system," because Swanson *et al.* teach that a message would be caught in response to a request for data. The identification of the ancillary system is NOT based on the message, as recited in the claim, but instead is based on a directory server as specifically pointed out by the Examiner in other parts of the rejection. (col. 6, lines 37-49). Moreover, nowhere do Swanson *et al.* teach or suggest "converting content from the message to enterprise information ..." and then "storing the enterprise information in the data processing system." Swanson *et al.* are simply unconcerned with establishing an enterprise repository for ancillary data.

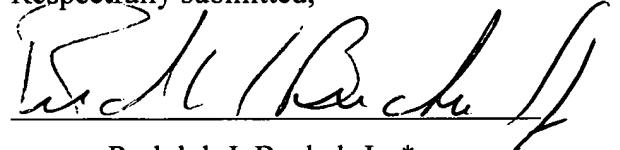
Since Swanson *et al.* do not teach or suggest each of the limitations in the above identified claims, the Examiner has not established a *prima facie* case of obviousness. It is respectfully asserted that rejection of claims **10** and **30** has been overcome and those claims are in condition for allowance.

III. Conclusion

It is respectfully urged that the subject application is patentable over Swanson *et al.* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



Date: December 30, 2003

Rudolph J. Buchel, Jr. *
Reg. No. 43,448
JONES DAY
P.O. Box 660623
Dallas, TX 75266-0623
Telephone: (214) 969-2990
Facsimile: (214) 969-5100

Attorney for Applicant

* Licensed in Florida
Not licensed in Texas